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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,967	10/19/2001	Hiromu Ueshima	100341-00017	7298

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EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,967

Applicant(s)

UESHIMA ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

In response to the RCE filed 10-8-2004.

This action is non-final.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 23rd, 2004 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim **10** is rejected under 35 U.S.C. 102(e) as being anticipated by Ng (6,328,570).

Ng teaches a portable karaoke unit including a removable memory cartridge, means for selecting a karaoke program from a plurality of karaoke programs store on the removable memory cartridge. Ng further teaches the inclusion of a cartridge sensing means and the utilization of identifiers to enable/disable cartridge content use.

Specifically Ng utilizes removable memory cartridge (135) capable of storing games programs and song related data including audio data, lyrics, timing information and graphical information (Col 3:37-44). Ng teaches the use of a menu system interface for directing the desired functionality of the unit (Fig 1, 5, 10 & Col 3:24-34). This menu interface description has been interpreted as the means of selecting the karaoke program and the means of selecting the game program from a plurality of similar stored programs.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **11-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (6,328,570).

Ng teaches a portable karaoke unit including a removable memory cartridge, means for selecting a karaoke program from a plurality of karaoke programs store on the removable memory cartridge. Ng further teaches the inclusion of a cartridge sensing means and the utilization of identifiers to enable/disable cartridge content use.

Specifically Ng utilizes removable memory cartridge (135) capable of storing games programs and song related data including audio data, lyrics, timing information and graphical information (Col 3:37-44). Ng teaches the use of a menu system interface for directing the desired functionality of the unit (Fig 1, 5, 10 & Col 3:24-34). This menu interface description has been interpreted as the means of selecting the

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karaoke program and the means of selecting the game program from a plurality of similar stored programs.

Ng teaches the determination of whether or not a cartridge is legal (620). An illegal cartridge is provided for as "the cartridge 135 is not a compatible cartridge, the identification information stored on the cartridge 135 is invalid... If it is not legal, then in step 630, karaoke unit 100 displays information about the illegal operation and the routine ends" (Col 7:28-33).

From the preceding the following is understood.

- I. Ng utilizes identifiers (held as equivalent to identification information) in order to determine compatibility.
- II. In order to determine (determination) whether or not an identifier is appropriate (legal) the base must perform a comparison or analysis of the identifier stored. This is resultant from the fact that the only processor shown (210) is located in the body of the device.
- III. Based on this determination an operation is either allowed to proceed or terminated.
- IV. The displaying of illegal information is considered equivalent to the displaying of a "warning message" and equivalent presented language.

In view of the preceding points it is understood that the invention of Ng would only allow the use of programs with corresponding identifiers to the based and that the detection of cartridge presence would be implicitly required for the analysis of

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information/programs contained on said cartridge. Ng however does not explicitly state that each program has a corresponding assigned identifier or that an identifier is stored in the base rather than the cartridge. It would have been obvious to one of ordinary skill in the art to store an identifier in the base in order to allow the processing unit of the base to determine the correspondence between the intended media and the present media device to insure compatibility. It would have been obvious to one of ordinary skill in the art at the time of invention to associate the identifier with the programs of Ng rather than the memory cartridge to allow reuse of the memory cartridge with multiple media playing devices.

Response to Arguments

Applicant's arguments with respect to claims 10-22 have been considered but are moot in view of the new ground(s) of rejection.

The new claim language has overcome the previously relied upon art however, a revised search directed to the presently claimed subject matter has yielded the patent applied in the rejections above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



JESSICA HARRISON
PRIMARY EXAMINER